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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,617	02/02/2004	Wolfgang Eis	AMB-131-02	2301

24131 7590 03/10/2006

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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/770,617	Applicant(s) EIS ET AL.	
	Examiner John Hoffmann	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-27 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that the terms such as "follow-up", "making-up" and "bush" are not defined in the specification and have no art-recognized meaning. Therefore the terms make the claims indefinite as to what the claims cover.

Claim 6: there is no antecedent basis for "the preforms" – the claim makes it unclear as to whether preforms are part of the apparatus – and as to whether claim 1 also requires preforms.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

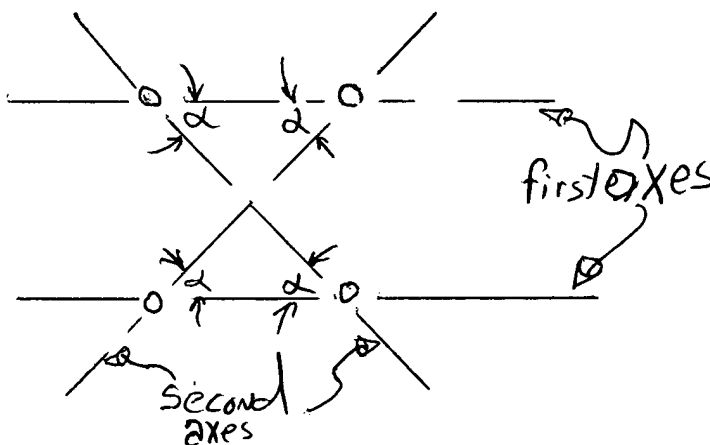
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 18-19, 25, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Gouronnec 4373943.

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See how the reference was previously applied. Claim 1 has been amended to require that there are axes which are disposed at an angle of that is less than 90 degrees. Whereas Gouronnec's array would have axes that are equal to 90 degrees, there are also axes that are approximately 45 degrees. The claims are comprising in nature and are thus also open to having other angles which are not less than 90. Note Applicant's complementary angles are greater than 90 degrees.

Specifically, the first matrix axes would be one of the two sets of parallel axes. The second matrix axes would be the diagonal axes.



Claim 4: To Examiner there are two ways to interpret claim 4: 1) all the spacings must be the same, or 2) all of the spacings on a given axis must be identical. Examiner could find no definition or direction in the specification that shows what is meant by the language. Given that the 2) is broader than 1), And given that the Office gives claims their broadest reasonable interpretation, it is deemed that the phrase "distances between...neighboring...bushes on each of said axes are identical" encompasses arrangements where the distances on one axis can be different from the distances on

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another axis, as long as the distances on a given axis are equal to all other distances on that same axis.

The PTO gives a disputed claim term its broadest reasonable interpretation during patent prosecution. Hyatt, 211 F.3d at 1372. The “broadest reasonable interpretation” rule recognizes that “before a patent is granted the claims are readily amended as part of the examination process.” Burlington Indus. v. Quigg, 822 F.2d 1581, 1583 (Fed. Cir. 1987). Thus, a patent applicant has the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application. In re Prater, 415 F.2d 1393, 1404-05 (CCPA 1969). Additionally, the broadest reasonable interpretation rule “serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.” In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting In re Yamamoto, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984)).

Since Gouronnec does not have more than one distance on a given axis, there are not “distances” between neighboring ones of said heating bushes on each axis. Thus claim 4 does not define over Gouronnec. In other words: the claim only serves to limit embodiments that actually has distances, it does not define over embodiments without distances on each axis. In still other words: since the claim does not explicitly require distances, the broadest reasonable interpretation is: if there are distances on each axis, then the distances are equal.

See the prior Office action for the treatment of the other dependent claims.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7 –8 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gouronnec 4373943 alone or in view of Watts 4204852.

See how claims 7-8 were treated in the prior Office action.

As to claim 4: See the above discussion. However, if claim 4 implicitly requires that there be distances, then by having multiple rows/columns would read on the claim.

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Arrangement of parts in rows and columns would not be considered a patentable invention.

From MPEP 2144.04

C. Rearrangement of Parts

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Claims 8 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gouronnec 4373943 alone or in view of Watts 4204852 as applied to claim 7 above, and further in view of Jensen 5062876.

Jensen teaches that putting fiber drawing arrangements in rows so as to maximize the packing density (col. 3, line4s 30-33). It would have been obvious to place the bushes into rows as claimed, so as to minimize the amount of factory floor area taken up by the apparatus.

Claims 9-11, 21-23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gouronnec 4373943.

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See the prior Office Action. Official Notice was taken of various facts in that Office Action. Such facts are now considered to be admitted prior art since Applicant has not traversed the Notice.

Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanghera in view of Gouronnec and Ishihara 2002/0078715.

See the prior Office Action and above.

Claims 1 and 11 and 13-17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanghera in view of Gouronnec .

See the prior Office Action and above.

Claims 1, 18 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Oh 6053013 in view of Gouronnec 4373943.

See the prior Office Action and above.

Claims 25-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Gouronnec as applied to claim 1 above, and further in view of Holschlag 3304163 (and optionally Watts 4204852).

See the prior Office Action and above.

Response to Arguments

Applicant's arguments filed 13 February 2006 have been fully considered but they are not persuasive.

It is argued that the terms 'follow up', "making up" and "bush" are "described" in the specification. This is not very relevant, because a description is not a definition.

The specification must clearly set forth the definition explicitly and with reasonable clarity, deliberateness and precision. *Teleflex Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.* 60 USPQ2d 1851, 1854 (fed. Cir. 2001) and MPEP 2111.01.

It is also argued that a person of ordinary skill knows that a bush is a cylindrical sleeve or collar. Applicant has not provided any evidence to support this assertion. On the contrary, Applicant points to instant figures 3 and 4 – which shows feature 15 which is not a cylindrical sleeve or collar – see also the specification which describes the bush as having extra features.

As to the argument that the term bush is used in many US patents. This is not persuasive. No evidence is supplied to support this assertion. Moreover there is no indication as to whether any of the patents actually define those terms to be as applicant now asserts the definition. Most importantly, there is no reason to believe that any of the patent constitute evidence that "bush" carries an art-recognized meaning.

It is further argued that applicant can be their own lexicographer. Applicant would need to actually set forth definitions in order actually create a lexicon.

It is argued that there is antecedent basis for “ the preforms” and that the preforms are introduced inferentially. This does not address all points of rejection. Specifically: It is unclear if the preforms are part of the apparatus.

It is argued that Gouronnec does not have the bushes as a matrix configuration. As pointed out above, one can consider the diagonal axes to be the second set of axes. Whereas Gouronnec also has axes which are 90 degrees, the claims do not preclude such.

It is also argued that the claimed invention has the advantage of a tight special configuration which avoids cold air streams. The claims do not require any tightness, the claims are open to having any distance between the bushes. The claims are open to having cold air streams as well.. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

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1986). Thus it does not matter that Sanghera, Watts or Hoschlag does not have the matrix as claimed: Gouronnec discloses such an arrangement.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

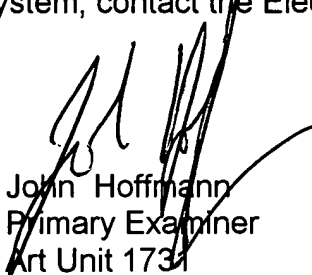
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

3-6-06

jmh